

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

REMARKS

Claims 1-18 are all the claims pending in the application. Claims 1-18 presently stand rejected. By this Amendment, Applicant editorially amends claim 15. The amendment to claim 15 was made to cure a minor informality, and does not narrow the literal scope of the claim and thus does not implicate an estoppel in the application of the doctrine of equivalents. The amendment to claim 15 was not made for reasons of patentability.

Preliminary Matters

Applicant thanks the Examiner for initialing the references listed on Form PTO/SB/08 A & B submitted with the Information Disclosure Statement filed on May 17, 2005. Additionally, Applicant thanks the Examiner for accepting the replacement drawing filed June 15, 2005.

Claim Objections

Claim 15 is objected to because of a minor informality. Applicant respectfully requests the Examiner to withdraw this objection in view of a self-explanatory claim amendment being made herewith.

Rejection under § 102(e)

Claims 17 and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,535,797 to Bowles et al. (hereinafter “Bowles”). Applicant respectfully traverses this rejection in view of the following comments.

Of these rejected claims, only claim 17 is independent. Independent claim 17, among a number of unique features includes: “a change control apparatus changing settings of the equipment control apparatus.” The Examiner alleges that claim 17 is directed to a power

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

management system and is anticipated by Bowles. Specifically, the Examiner alleges that the Intelligent Electronic Devices (IEDs) and the substations, as disclosed in Bowles, are equivalent to the change control apparatus and the equipment control apparatus, respectively, as set forth in claim 17 (*see page 3 of the Office Action*). Applicant respectfully disagrees. Applicant has carefully studied Bowles' discussion of the IEDs 42, which do not change the settings of the substations 16.

Bowles discloses that each substation 16 may also include a plurality of controllable devices in the form of Intelligent Electronic Devices (IED) 42, which are coupled with a respective communications device 20. Each IED 42 may be configured as *e.g.*, a circuit breaker; a capacitor bank; a relay; or a switch which is controllably actuated using data transmitted to and from communications device 20 via line 44 (col. 5, lines 4 to 10). That is, the IEDs are controllable devices that are actuated and controlled by the substation 16 (col. 5, lines 39 to 54) and not vice versa. In other words, the IEDs 42 of Bowles, alleged change control apparatus, do not change the settings of the substation 16, alleged equipment control apparatus. On the contrary, the substation 16 actuates and controls the IEDs 42.

Therefore, “a change control apparatus changing settings of the equipment control apparatus,” as set forth in claim 17, is not disclosed by Bowles, which lacks IEDs that would change the setting of the equipment control apparatus. For at least these exemplary reasons, claim 17 is patentably distinguishable from Bowles. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 17. Claim 18 is patentable at least by virtue of its dependency.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

In addition, claim 18 recites: “an internal memory storing information being changed by the change control apparatus, and wherein, when the equipment control apparatus receives a confirmation via the dedicated communication network...” The Examiner did not address these unique features of claim 18 (*see* page 4 of the Office Action). It is respectfully noted that Bowles does not teach or suggest a substation 16 (alleged equipment control apparatus) having two memories (a common memory and an internal memory). Bowles discloses the substation 16 only having one memory 26 (Fig. 1; col. 3, lines 62 to 65). Moreover, there is no confirmation message disclosed in Bowles. For at least these additional exemplary reasons, claim 18 is patentably distinguishable over Bowles.

Rejection under § 103(a)

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bowles in view of U.S. Patent Application Publication No. 2002/0107615 A1 to Bjorklund (hereinafter “Bjorklund”).¹ Applicant respectfully traverses in view of the following comments.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Thrif*, 298

¹ Applicant believes the Examiner meant claims 1-16 and not claims 1-18, as in the detailed discussion of this rejection, only claims 1-16 are addressed.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

F.3d 1357, 1363 (Fed. Cir. 2002).

- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

In the present case, at least the first and third prongs are not satisfied.

To begin, there is no motivation to combine the references in the manner suggested by the Examiner. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless, if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* ***A broad conclusionary statement, standing alone without support, is not “evidence.”*** *Id.*; see also, *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, ***with no knowledge of the***

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner alleges that one of ordinary skill in the art would have been motivated to include the firewall of Bjorklund with the system of Bowles in order to “obtain electric substation for transmission and distribution of electric energy with a flexibility, drastic reduction in cabling, improved performance” (*see* page 6 of the Office Action). It is respectfully submitted that, at the very least, it is unclear how flexibility and performance of the system will be increased with a firewall and a bridge. Moreover, the Examiner has not provided motivation to add the firewall to only one of the two communication systems, especially since according to the Examiner, the firewall is not added to the web communication system but to the dedicated communication system. If one of ordinary skill in the art would have added the firewall, it would have been to the web communication system because firewalls are considered useful for web communications.

Indeed, but for the present invention, there is no suggestion or motivation to make one communication line more secure than the other. In short, the Examiner is exercising impermissible hindsight in an attempt to combine these two very different references and there is no motivation to combine the references in the manner suggested by the Examiner as flexibility will not be increased with an addition of a firewall and a bridge.

Moreover, the third prong is also unsatisfied. As Bowles and Bjorklund, taken alone or in any conceivable combination, fail to teach or suggest the unique features of the claims.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

Of these rejected claims, only claims 1 and 7 are independent. Independent claims 1 and 7 include some variation of changing a function of an equipment control apparatus from outside of said equipment control apparatus via a secure communication and having the secure communication of a higher security than the web communication. The Examiner alleges that the equipment control apparatus and the secure communication set forth in these independent claims are equivalent to the substation and the line 44, respectively, as disclosed in Bowles and that Bjorklund discloses higher security communication. Applicant respectfully disagrees. Applicant has carefully studied the combined teachings of Bowles and Bjorklund and respectfully submits that, in the combined teachings of Bowles and Bjorklund, there is no additional communication line for changing a function of the substation where the additional communication line is of higher security than the web communication used for monitoring.

Bowles discloses an electrical distribution system 10 having substations 16, where the substations 16 control Intelligent Electronic Devices (IEDs). The substations 16 communicate with the monitoring devices 36 and 38 via communication network 12 (Fig. 1; col. 5, lines 11 to 24). That is, in Bowles, the function of the substations (alleged equipment control apparatus) may be changed only via the communication network 12 (alleged Web system). The communication line 44 is only provided to control the IEDs and not the functions of the substations 16. The substations 16 are controlled only via the communication network 12. Moreover, as acknowledged by the Examiner, Bowles fails to teach or suggest one communication system being more secure than the other communication system.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

Bjorklund fails to cure the deficient teachings of Bowles. Bjorklund only discloses having a LAN with a bridge and a firewall (¶ 100). Bjorklund, however, fails to teach or suggest having one communication system more secure than another.

Accordingly, changing a function of an equipment control apparatus from outside of said equipment control apparatus via a secure communication and having the secure communication of a higher security than the web communication as set forth in claims 1 and 7 is not taught or suggested by the combined teachings of Bowles and Bjorklund, which lack having the substations controlled via a second communication which is more secure than another communication line.

Based on at least the foregoing reasons, Applicant respectfully submits that the combination of Bowles and Bjorklund fails to disclose all of the claimed elements as arranged in claims 1 and 7. Therefore, the combination of Bowles and Bjorklund clearly cannot render the present invention, as recited in claims 1 and 7, obvious. Thus, Applicant submits that claims 1 and 7 are allowable and further submits that claims 2-6 and 8-16 are allowable as well, at least by virtue of their dependency. Applicant respectfully requests the Examiner to reconsider and to withdraw the § 103(a) rejection of claims 1-16.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,831
Attorney Docket No.: Q68496

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Nataliya Dyerson
Registration No. 56,616

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: September 7, 2005

Attorney Docket No.: Q68496